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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,551	06/29/2006	Xin Qi	36290-0408-00-US	4948

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EXAMINER	
HOLLOMAN, NANNETTE	

ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,551	QI ET AL.	
	Examiner	Art Unit	
	NANNETTE HOLLOMAN	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *6-9,18-30 and 32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-5,10-17,31 and 33* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08 May 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-33 are pending. Applicant's preliminary amendment filed of 08 May 2006 amending claims 1-5, 10-17, 31 and 33 and cancelling claims 6-9, 18-30 and 32 is acknowledged. This is the first action on the merits of the claims.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (p. 3). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "treating", does not reasonably provide enablement for "preventing". The specification does not enable any person skilled in

the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

To be enabling, the specification of the patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1561 (Fed. Cir. 1993). Explaining what is meant by "undue experimentation," the Federal Circuit has stated:

> The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the claimed invention. PPG v. Guardian, 75 F.3d 1558, 1564 (Fed. Cir. 1996).[1]

The factors that may be considered in determining whether a disclosure would require undue experimentation are set forth by In re Wands, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing Ex parte Forman, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

1) the quantity of experimentation necessary,
2) the amount of direction or guidance provided,
3) the presence or absence of working examples,
4) the nature of the invention,
5) the state of the prior art,
6) the relative skill of those in the art,
7) the predictability of the art, and
8) the breadth of the claims.

These factors are always applied against the background understanding that scope of enablement varies inversely with the degree of unpredictability involved. In re

Fisher, 57 CCPA 1099, 1108, 427 F.2d 833, 839, 166 USPQ 18, 24 (1970). Keeping that in mind, the Wands factors are relevant to the instant fact situation for the following reasons:

1. The nature of the invention, state and predictability of the art, and relative skill level

The invention relates to "preventing". The relative skill of those in the art is high, that of an MD or PHD. That factor is outweighed, however, by the unpredictable nature of the art. As illustrative of the state of the art, the examiner cites Lindley et al. (Seminars in Neonatology, Vo. 8, pp. 259-265, 2003) discloses some therapies are unable to prevent hypoglyceamia (Summary).

2. The breadth of the claims

Since the instant specification provides no limiting definition of the term "prevention", the term will be interpreted expansively. The term "prevention" may vary widely in meaning, from "preventing" a disease from occurring to "preventing" it from progressing. Nor is the term limited by any time frame.

The claims are thus very broad insofar as they suggest that one will not experience the disease when taking the claimed agent; that should one get the disease, it will not worsen; or that following its treatment, it will not recur. While such "prevention" might theoretically be possible under strictly controlled laboratory conditions, as a practical matter it is nearly impossible to achieve in the "real world" in which patients live.

[1] As pointed out by the court in In re Angstadt, 537 F.2d 498 at 504 (CCPA 1976), the key word is

3. The amount of direction or guidance provided and the presence or absence of working examples

The specification provides no direction or guidance for practicing the claimed invention in its "full scope". No reasonably specific guidance is provided concerning useful therapeutic protocols for "preventing", other than those with a disease and not the general population. The latter is corroborated by the working examples.

4. The quantity of experimentation necessary

Because of the known unpredictability of the art, and in the absence of experimental evidence, no one skilled in the art would accept the assertion that the instantly claimed agents could be predictably used to "prevent" as inferred by the claim and contemplated by the specification. Accordingly, the instant claims do not comply with the enablement requirement of §112, since to practice the claimed invention in its "full scope" a person of ordinary skill in the art would have to engage in undue experimentation, with no assurance of success.

5. Suggested alternative language

Since the term "treating" is inclusive of various administrative timing schemes and thus provides adequate coverage for all reasonably successful therapies (prophylactic or active), the examiner recommends deleting the term "preventing" and simply reciting "treatment" only instead.

"undue", not "experimentation".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claims 1-3, 11-12 and 33 rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (WO 02/34271 A1).

Hansson et al., which is directed to a composition of heat treated starch for the prevention of hypoglycaemia in patients with diabetes or liver disease (instant claim 1-3, 11-12 and 33) (Abstract and p. 8, lines 9-11, claim 6), discloses a method for stabilizing the blood sugar levels and avoiding the oscillation between unhealthy high and low blood sugar levels (p. 8, lines 27-28).

2) Claims 1-4, 13-14 and 33 rejected under 35 U.S.C. 102(b) as being anticipated by Schmiedel et al. (U.S. Patent Publication No. 2003/0054501 A1).

Schmiedel et al. disclose a food composition with waxy maize (corn) starches (claim 14 and 33) (paragraphs [0018]-[0019]). Schmiedel et al. further discloses a hydrothermally treated starch (claim 4) (paragraph [0028]). Schmiedel discloses the waxy starch has amylase content of <10% (claim 13) (paragraph [0033]). The instant specification defines a "waxy" starch as containing <20% amylase (80% amylopectin) (Specification, p. 19, lines 17-18). Schmiedel et al. disclose the process of using

hydrothermally treated starches improves the quality and quantity of products made (paragraph [0017]). In regards to instant claims 1-3, it is known that the consumption of starch by a human increases glucose levels[2], which would in fact treat hypoglycaemia.

3) Claims 1-3, 5, 17 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohrmann et al. (U.S. Patent No. 4,418,090).

Bohrmann et al. which is directed to a food product, discloses the use of heat moisture treated starches (claim 5) (Abstract and column 6, lines 32-35). Bohrmann et al. discloses a food composition that contains greater than 50 g of starch (claim 17) (column 8, line 21). In regards to instant claims 1-3, it is know that the consumption of starch by a human increases glucose levels[2], which would in fact treat hypoglycaemia.

4) Claims 1-3 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbertson et al.

Gilbertson et al. disclose a food composition which contains starch (Abstract and paragraph [0016]). Gilbertson et al. further discloses a kit comprising instructions (claim 31) (paragraph [0012]). Gilbertson et al. also discloses the food composition which contains starch being hydrothermally treated (paragraph [0078]). In regards to instant claims 1-3, it is know that the consumption of starch by a human increases glucose levels[2], which would in fact treat hypoglycaemia.

[2] Metabolic Energy (Stryer, Biochemistry, Metabolic Energy, Third Edition, p.342, 1988). This reference is

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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used to disclose that starch is hydrolyzed into glucose when ingested by humans and is not relied upon for the basis of the rejection.

Claims 1-3, 10-11, 15-16 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman (U.S. Patent No. 5,605,893) and Schmiedel et al. (U.S. Patent Publication No. 2003/0054501 A1.

Kaufman discloses a therapeutic food composition containing starch for treatment of diabetic patients to prevent hypoglycemic episodes and diminish fluctuations in blood sugar levels (claims 1-3 and 33) (Abstract). Kaufman further discloses treating patients having glycogen storage disease and Type I or II diabetes (claims 10-11) (column 1, lines 64-65 and column 2, lines 46). Kaufman discloses maintaining blood sugar levels above 60 mg/dl (converted to 3.33mmol/l) for as long as 8-9 hours, which meets the limitation of instant claims 15 and 16 (column 4, lines 28-30).

Kaufman does not disclose a therapeutic food composition containing waxy or hydrothermally treated starch.

Schmiedel et al. is discussed above and discloses the benefits of using a hydrothermally treated waxy starch.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the hydrothermally treated waxy starch in the composition of Kaufman motivated by the desire to produce a product of improved quality at a larger quantity as disclosed by Schmiedel et al.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612